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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,001	02/11/2004	Nobuyuki Nagai	09792909-5806	3428

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EXAMINER

BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
1773	

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,001

Applicant(s)

NAGAI, NOBUYUKI

Examiner

Kevin M. Bernatz

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Response to Amendment

1. Amendments to claim 1 and cancellation of claims 2 and 3, filed on June 28, 2006, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 1 and 4 – 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Motohashi (U.S. Patent App. No. 2004/0126622 A1) – **and** –
4. Claims 1 and 4 – 6 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter, since Motohashi appears to have invented the claimed subject matter for the reasons noted below.

The above rejections are maintained for the reasons of record as set forth in Paragraph No.'s 3 and 4 of the Office Action mailed on March 28, 2006.

Regarding the amended language “a thickness of said ... satisfy said conditions”, the Examiner notes that these limitations were previously addressed with regard to prior claims 2 and 3. Regarding the amended language “said magnetic layer having a double-layered structure composed of a lower magnetic thin film and an upper magnetic thin film”, the Examiner notes that Motohashi teaches such a structure (*Abstract*).

5. Claims 1 and 4 – 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Motohashi (U.S. Patent App. No. 2005/0266273 A1) – **and** –

6. Claims 1 and 4 – 6 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter, since Motohashi appears to have invented the claimed subject matter for the reasons noted below.

The above rejections are maintained for the reasons of record as set forth in Paragraph No.'s 5 and 6 of the Office Action mailed on March 28, 2006.

Regarding the amended language "a thickness of said ... satisfy said conditions", the Examiner notes that these limitations were previously addressed with regard to prior claims 2 and 3. Regarding the amended language "said magnetic layer having a double-layered structure composed of a lower magnetic thin film and an upper magnetic thin film", the Examiner notes that Motohashi teaches such a structure (*Abstract*).

Claim Rejections - 35 USC § 103

7. Claims 1 and 4 – 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takai et al. (U.S. patent No. 4,770,924) in view of Saito et al. (either JP 2002-025033 A or U.S. Patent App. No. 2002/0018918 A1). See Saito et al. ('918 A1), which is the English language equivalent of JP '033 A.

The above rejections are maintained for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on March 28, 2006.

Regarding the amended language "a thickness of said ... satisfy said conditions", the Examiner notes that these limitations were previously addressed with regard to prior

claims 2 and 3. Regarding the amended language “said magnetic layer having a double-layered structure composed of a lower magnetic thin film and an upper magnetic thin film”, the Examiner notes that Takai et al. teach such a structure (*Abstract*).

Response to Arguments

8. The rejection of claims 1 and 4 - 6 under 35 U.S.C § 102(e) and/or 102(f) – Motohashi ('622 A1)

Applicant(s) argue(s) that Motohashi fails to teach a dual magnetic layered structure (*page 4 of response*). The Examiner respectfully disagrees.

Motohashi discloses such a structure in their abstract and entire disclosure. Regarding applicants' argument that the combined features of claims 1 – 3 result in a patentable invention, the Examiner respectfully disagrees. The Examiner notes that Motohashi explicitly teaches controlling the combined properties to within the claimed ranges.

9. The rejection of claims 1 and 4 - 6 under 35 U.S.C § 102(e) and/or 102(f) – Motohashi ('273 A1)

No arguments were presented to refute the Examiner's position of anticipation.

10. The rejection of claims 1 and 4 - 6 under 35 U.S.C § 103(a) – Takai et al. in view of Saito et al.

No arguments were presented to refute the Examiner's position of obviousness.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB
August 29, 2006


Kevin M. Bernatz, PhD
Primary Examiner